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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,954	07/07/2003	Thomas M. Hohn	30884D	7143

7590 08/13/2004  
Larry W. Stults, Ph.D.  
Syngenta Biotechnology, Inc.  
3054 Cornwallis Road  
Research Triangle Park, NC 27709

EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,954	<b>Applicant(s)</b> HOHN ET AL.	
	<b>Examiner</b> Medina A Ibrahim	<b>Art Unit</b> 1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I in the reply filed on 07/23/04 is acknowledged.

Claims 1-6 are pending.

Claims 1-5 are under consideration.

Claim 6 has been withdrawn from consideration as being directed to a non-elected invention.

### ***Drawings***

The Examiner approves the drawings filed on 07/07/03.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 07 July 2003 has been considered. However, references AS, AU and BA listed on page 2 of the IDS form 1449 will not be published on the face of the patent because they cite a hyperlink directed to an Internet address. The use of hyperlinks in the IDS is not allowed under USPTO current policy because the Internet address is subject to a change. Therefore, references AS, AU and BA are inappropriate references for publication on the face of the patent.

### ***Specification***

The disclosure is objected to because of the following informalities: for example page 5, lines 22-23, and page 8, line 13, cite a hyperlink directed to an Internet address. The use of hyperlinks is not permitted under USPTO current policy because the content

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of such links are subject to a change, resulting in the introduction of New Matter into the specification. Appropriate correction is required.

### ***Priority***

The status of the U.S. Appl. No 10/074,279 on page 1, 1<sup>st</sup> paragraph, of the specification should be updated, i.e.----now US PAT 6,646,184--- should be inserted after "2002," in line 4.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 17-28, 186-200, and 231-245 of U. S. Patent No. 6,346,655. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in both the application and the patent are directed to a transgenic host cell comprising SEQ ID NO: 5 or a nucleotide sequence encoding SEQ ID NO: 6. The transgenic host cell comprising a

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chimeric gene comprising a nucleotide sequence encoding SEQ ID NO: 6 operably linked to a heterologous promoter is generic to a transgenic plant cell comprising a nucleotide sequence encoding SEQ ID NO: 6, and a transgenic plant cell comprising SEQ ID NO: 5 or nucleotide sequence having less than 100% sequence identity thereto. While the claims in the patent do not recite a "chimeric gene", a chimeric gene comprising a specific DNA is an obvious form of the specific DNA itself, since chimeric gene or recombinant DNA is the basis of the entire biotechnology industry. Also, a claim drawn to a transgenic plant cell comprising SEQ ID NO: 5 is generic to a claim drawn to SEQ ID NO: 5. Since the claims in both this application and the application from the application (09/538,414) which gave rise to the '655 patent) were not subject to a restriction requirement, the obviousness double patenting rejection is proper.

### ***Remarks***

No claim has been allowed.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM. Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mai

8/9/04

Medina A. Ibrahim  
1638

**MEDINA A. IBRAHIM  
PATENT EXAMINER**